

REMARKS

Claims 5-9, 15, and 18-31 are currently pending in the above-referenced application. Claims 5-9 and 15 are currently amended and new claims 18-31 are presented. Claims 1-4, 10-14, and 16-17 have been cancelled without prejudice. No new matter has been introduced by the amendments provided herein.

Claim Objections

The Examiner has objected to the form of presentation of amendments in the preliminary amendment by stating that “[b]racketing deleted material is no longer used in the manner of making amendments.” Applicants respectfully point out that 37 CFR 1.121 (c)(2) provides that the “text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters.” (emphasis added). MPEP 714 II C (B) confirms that double bracketing is appropriate and even required in certain circumstances. Applicants maintain that the preliminary amendments were proper and in accordance with permitted usage of double brackets to reflect deletions of five or fewer characters.

The objection to claim 14 is now moot in view of its cancellation.

Claim Rejections – 35 USC §112

The Examiner has rejected claim 17 as allegedly lacking enablement under 35 USC §112, first paragraph. While Applicants do not concede the propriety of this rejection, Applicants note that the rejection is now moot in view of the cancellation of claim 17.

The Examiner has rejected claims 11, 14, 16, and 17 as allegedly indefinite under 35 USC §112, second paragraph. While Applicants do not concede the propriety of this rejection, Applicants note that the rejection is now moot in view of the cancellation of claims 11, 14, 16, and 17.

Claim Rejections – 35 USC §102

The Examiner has rejected claims 10, 11, 16, and 17 as allegedly anticipated by GB2126224 (GB224). This rejection is now moot in view of the cancellation of claims 10, 11, 16, and 17. Additionally, Applicants note that claim 18 is the only independent claim currently

in the application and that GB224 does not disclose compounds having the ureido moiety required in the general formula I of claim 18. For this reason among others the pending claims are not anticipated by GB224.

The Examiner has rejected Claims 1-6, 8, 14 and 15 as allegedly anticipated by Deck et al., *Journal of Heterocyclic Chemistry* (2000), 37(4), 675-680 (Deck). The rejections of claims 1-4 and 14 are moot in view of the cancellation of these claims. The examiner cites a compound disclosed by Deck having an ureido moiety and an amido moiety linked by an ethylene moiety. By contrast the general formula I of new claim 18 requires that the linker, Z', between the ureido moiety and the amido moiety of the claimed compounds must be either a propylene or a cyclohexyl moiety. Consequently, the cited compound does not anticipate the compounds of the new independent claim 18 or claims 5-9, 15, and 19-31 which depend from claim 18.

The Examiner has rejected Claims 1-6, 8, 14 and 15 as allegedly anticipated by Lee et al., *Heterocycles* (1994), 38(12), 2605-14 (Lee). The rejections of claims 1-4 and 14 are moot in view of the cancellation of these claims. The examiner cites a compound disclosed by Lee having an ureido moiety and an amido moiety linked by a methylene moiety. By contrast the general formula I of new claim 18 requires that the linker, Z', between the ureido moiety and the amido moiety of the claimed compounds must be either a propylene or a cyclohexyl moiety. Consequently, the cited compound does not anticipate the compounds of the new independent claim 18 or claims 5-9, 15, and 19-31 which depend from claim 18.

The Examiner has rejected Claims 1, 2, 4-6, 8, 14 and 15 as allegedly anticipated by Machacek et al., *Collection of Czechoslovak Chemical Communications* (1987), 52(1), 140-55 (Machacek). The rejections of claims 1, 2, 4 and 14 are moot in view of the cancellation of these claims. The examiner cites two compounds disclosed by Machacek having an ureido moiety and an amido moiety linked by a methylene moiety. By contrast the general formula I of claim 18 requires that the linker, Z', between the ureido moiety and the amido moiety of the claimed compounds must be either a propylene or a cyclohexyl moiety. Consequently, the cited compounds of Machacek do not anticipate the compounds of the new independent claim 18 or claims 5-9, 15, and 19-31 which depend from claim 18.

Claim Rejections – 35 USC §103

Obviousness under 35 U.S.C. §103(a) is a question of law based on underlying factual inquiries. According to the MPEP, the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness, where “the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made” and in view of all factual information, “make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person” keeping in mind that “impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art” MPEP §2142.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious” as illustrated by the comment by the Supreme Court that the analysis should be made explicit. (MPEP §2142, citing *KSR International Co. v. Teleflex Inc.* (hereinafter, *KSR*), 82 USPQ2d 1385, 1396 (2007) “[R]ejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (MPEP §2142, quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006); see also *KSR*, 82 USPQ2d at 1396, quoting the Federal Circuit statement with approval).

The Examiner has rejected claims 12 and 13 under 35 USC §103(a) as allegedly obvious over GB224. This rejection is moot in view of the cancellation of these claims. Additionally, Applicants note GB224 does not disclose compounds having, *inter alia*, the ureido moiety required in general formula I of claim 18, the sole pending independent claim. Here, rejections of the pending claims under 35 U.S.C. §103(a) over GB224 would be improper because the initial burden of factually supporting a *prima facie* conclusion of obviousness has not been met by the mere assertion of structural similarity without any basis for altering the recited compounds of GB224 to arrive at the compounds of the invention. The Office Action does not set forth the required “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” in view of the disclosure in GB224 and therefore, no *prima facie* case of obviousness has been made and the rejections should be withdrawn.

The Examiner has rejected claims 7 and 9 under 35 USC §103(a) as allegedly obvious over each of Deck, Lee, and Machacek. Applicants note again that none of Deck, Lee, and Machacek teach the claimed compounds having an ureido moiety and an amido moiety linked by a propylene or cyclohexyl moiety. Here, rejections of the pending claims under 35 U.S.C. §103(a) over any or all of Deck, Lee, and Machacek are improper because the initial burden of factually supporting a *prima facie* conclusion of obviousness has not been met by the mere assertion of structural similarity without any basis for altering the recited compounds of Deck, Lee, and Machacek to arrive at the compounds of the invention. The Office Action does not set forth the required “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” in view of the disclosure in Deck, Lee, and Machacek and therefore, no *prima facie* case of obviousness has been made and the rejections should be withdrawn.

CONCLUSION

For the foregoing reasons, Applicants submit that the pending claims as amended are allowable and accordingly request the withdrawal of the pending objections and rejections and the allowance of the pending claims.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

PILLSBURY WINTHROP SHAW PITTMAN LLP



RICHARD L. BLAYLOCK

Reg. No. 43503

Tel. No. 858 847.4110

Fax No. 858 509.4010

Date: October 10, 2008
12255 El Camino Real
Suite 300
San Diego, CA 92130
(619) 234-5000